

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Jennifer Reed

Confirmation No.: 5467

Application No.: 10/823,810

Group Art Unit: 1646

Filed: April 12, 2004

Examiner: Chandra, Gyan

For: METHODS OF PREVENTING OR TREATING
RESPIRATORY CONDITIONS Attorney Docket No.: IL500US

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT

UNDER 37 C.F.R. § 1.705(b)

Applicant hereby requests reconsideration of the patent term adjustment (PTA) indicated in the Notice of Allowance mailed on November 11, 2008. This paper is filed after the mailing of the Notice of Allowance on November 11, 2008, but no later than the payment of the issue fee. Please charge the fee set forth in 37 C.F.R. § 1.18 (e) and any other fee necessary for consideration of this paper to our Deposit Account No. 500479.

Statement of Facts

1. Applicant respectfully submits that the correct PTA under 35 U.S.C. § 154 (b) is 897 days as of the filing of this paper on February 24, 2009 plus one additional day for each calendar day between the date of filing this paper (February 24, 2009) and the issue date. The bases for the reconsideration of the PTA are:

- (i) the USPTO's lack of accounting for its failure to issue a patent within three years of the actual filing date of the application as required under 35 U.S.C. § 154 (b) (1) (B) (hereinafter "B delay"; adjustment period for B delay is calculated pursuant to 37 C.F.R. § 1.703 (b)); and
- (ii) the addition of these B delay days to any patent term adjustment which Applicant accrued prior to the date that is three years from filing the application under 35 U.S.C. § 154 (b) (1) (A) (hereinafter "A delay"; adjustment period for A delay is calculated pursuant to 37 C.F.R. § 1.703 (a)). *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D.D.C. 2008) (holding that A and B delay periods can "overlap" only if they occur on the same calendar day).

As discussed in the sections that follow (2-4) the number of days of PTA for the patent issuing from this application should be 897 days plus the number of days between the date of filing this paper and the issue date.

2. Applicant respectfully submits that there are two relevant time periods under 37 C.F.R. § 1.703 (a)-(e) for adjustment of patent term.

(i) The first such time period is the A delay specified under 37 C.F.R. § 1.703 (a). As indicated in PAIR, the A delay period is 467 days: the period beginning on the day after the date that is fourteen months after the date on which the application was filed (June 13, 2005) and ending on the date of mailing an action under 35 U.S.C. § 132 (September 22, 2006).

(ii) The second such time period is specified under 37 C.F.R. § 1.703 (b). Under 37 C.F.R. § 1.703 (b), the period of adjustment is the number of days in the time period beginning three years after the date on which the application was filed under 35 U.S.C. § 111 (a) (April 13, 2007) and ending on the date the patent issues. As of today, February 24, 2009 this is 712 days. Because the patent was not yet issued an additional day will accrue for each day until the patent issues. According to 37 C.F.R. § 1.703 (b) (4), this number is to be reduced by the number of days beginning on the date on which a notice of appeal to the BPAI was filed (October 15, 2008)

and ending on the date of mailing a notice of allowance (November 24, 2008), if the appeal did not result in a decision by the BPAI. This is a 37-day period. Subtraction of this 37-day period from the 712 days provides 675 days (plus an additional day for each day from today until the patent issues) in the second time period.

Because the *Wyeth* court held that the A and B delay periods under 37 C.F.R. § 1.703 (a) and (b), respectively, overlap only if they occur on the same day, the A and B delay periods due to USPTO delays in the examination of the instant application do not overlap as construed by the *Wyeth* court, they should be added together. Therefore the period of adjustment due to USPTO delays on today, February 24, 2009 equals $467+675=1142$ days. To the 1142 days the number of days between the date of filing this paper (February 24, 2009) and the issue date should be added.

3. The patent issuing from the present application is not subject to a terminal disclaimer.
4. As indicated in PAIR, Applicant's delay in concluding processing and examination is 245 days.

In consideration of the facts described above, Applicant respectfully submits that as of today, February 24, 2009 the PTA equals

$$\begin{array}{rcl} 1142 & \text{days due to USPTO delay (see 2, above)} & \\ - 245 & \text{days due to Applicant delay (see 3, above)} & \\ \hline 897 & \text{days.} & \end{array}$$

In addition, a further day of PTA should be accorded for each day between the date of filing this paper (February 24, 2009) and the issue date.

Respectfully submitted,

Date

February 24, 2009



Miklos Gaszner
MedImmune, Inc.
One MedImmune Way
Gaithersburg, MD 20878
Telephone: 301-398-5332

(61,314)